

ESTTA Tracking number: **ESTTA356473**Filing date: **07/06/2010**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	Internet Employment Linkage, Inc. d/b/a HigherEdJobs		
Entity	Corporation	Citizenship	Illinois
Address	1010 Lake Street Oak Park, IL 60301 UNITED STATES		

Attorney information	Elizabeth R. Burkhard Holland & Knight LLP 10 St. James Avenue Boston, MA 02116 UNITED STATES elizabeth.burkhard@hklaw.com Phone:617-523-2700
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**Registration Subject to Cancellation**

Registration No	3666461	Registration date	08/11/2009
Registrant	AmeriCareers, LLC Suite 218 5000 Northwind Dr. East Lansing, MI 48823 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 041. First Use: 2009/04/18 First Use In Commerce: 2009/04/18 All goods and services in the class are cancelled, namely: On-line computer services, namely, providing a web-based system and online portal for higher education communities with online directories featuring colleges, graduate schools, courses, scholarships, jobs, news, events, classified ads, virtual community and social networking
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**Grounds for Cancellation**

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Priority and likelihood of confusion	Trademark Act section 2(d)


**Marks Cited by Petitioner as Basis for Cancellation**


U.S. Registration No.	2688003	Application Date	03/30/2001
Registration Date	02/18/2003	Foreign Priority Date	NONE
Word Mark	HIGHEREDJOBS.COM		

Design Mark	<b>HIGHEREDJOBS.COM</b>
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 1996/12/10 First Use In Commerce: 1996/12/10 Personnel placement and recruitment services for academic professionals and faculty; providing access to data and the ability to manipulate data [ related data ] related to personnel placement and recruiting services, namely, employment candidate information, job finding tools, institutional profiles and job posting data for academic professionals and faculty; providing a website featuring information and weblinks in the field of employment for academic professionals and faculty

U.S. Registration No.	2781127	Application Date	03/30/2001
Registration Date	11/11/2003	Foreign Priority Date	NONE
Word Mark	HIGHEREDJOBS.COM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1999/12/01 First Use In Commerce: 1999/12/01 Personnel placement and recruitment services for academic professionals and faculty; providing access to data and the ability to manipulate data related to personnel placement and recruiting services, namely, employment candidate information, job finding tools, institutional profiles and job posting data for academic professionals and faculty; providing a website featuring information and weblinks in the field of employment for academic professionals and faculty		

U.S. Application No.	77950871	Application Date	03/04/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	HIGHEREDJOBS		

Design Mark	
Description of Mark	The mark consists of the words "HigherEdJobs" with a downwardly curved arrow pointing from above the "i" in "Higher" to above the "J" in "Jobs." .
Goods/Services	Class 035. First use: First Use: 2010/02/28 First Use In Commerce: 2010/02/28 Personnel placement and recruitment services for academic professionals and faculty; providing access to data and the ability to manipulate data related to personnel placement and recruiting services, namely, employment candidate information, job finding tools, institutional profiles and job posting data for academic professionals and faculty; providing a website featuring information and weblinks in the field of employment for academic professionals and faculty Class 041. First use: First Use: 2010/02/28 First Use In Commerce: 2010/02/28 On-line journals, namely, blogs featuring employment news and discussion

U.S. Application No.	77950843	Application Date	03/04/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	HIGHEREDJOBS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1996/12/10 First Use In Commerce: 1996/12/10 Personnel placement and recruitment services for academic professionals and faculty; providing access to data and the ability to manipulate data related to personnel placement and recruiting services, namely, employment candidate information, job finding tools, institutional profiles and job posting data for academic professionals and faculty; providing a website featuring information and weblinks in the field of employment for academic professionals and faculty Class 041. First use: First Use: 2010/01/29 First Use In Commerce: 2010/01/29 On-line journals, namely, blogs featuring employment news and discussion		

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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Elizabeth R. Burkhard/
Name	Elizabeth R. Burkhard
Date	07/06/2010

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Internet Employment Linkage, Inc. d/b/a

HigherEdJobs,

Petitioner,

v.

AmeriCareers, LLC,

Registrant.

Cancellation No. \_\_\_\_\_

Registration No. 3,666,461

**PETITION TO CANCEL REGISTRATION**

In the matter of Registration No. 3,666,461 (“the ‘461 Registration”), for the mark **HIGHER ED SPACE** (hereinafter “Registrant’s Mark”), for “On-line computer services, namely, providing a web-based system and online portal for higher education communities with online directories featuring colleges, graduate schools, courses, scholarships, jobs, news, events, classified ads, virtual community and social networking” in International Class 41 (hereinafter “Registrant’s Services”), registered on August 11, 2009 by AmeriCareers, LLC (hereinafter “Registrant”); Internet Employment Linkage, Inc. d/b/a Higher Ed Jobs, a corporation organized and existing under the laws of the State of Illinois and having a principal place of business at 1010 Lake Street, Oak Park, Illinois 60301 (hereinafter “Petitioner”), believes it will be damaged by the continued registration of the Registrant’s Mark and hereby petitions to cancel Registration No. 3,666,461 for said mark.

The grounds for cancellation are as follows:

1. Petitioner is the owner of all right, title, and interest in and to the trade name and service mark **HIGHEREDJOBS** and the service mark **HIGHEREDJOBS.COM** (hereinafter, “Petitioner's Marks”) for personnel placement and recruitment services for academic professionals and faculty; providing access to data and the ability to manipulate data related to personnel placement and recruiting services, namely, employment candidate information, job finding tools, institutional profiles and job posting data for academic professionals and faculty; providing a website featuring information and weblinks in the field of employment for academic professionals and faculty; and on-line journals, namely, blogs featuring employment news and discussion (hereinafter, “Petitioner’s Services”).

2. Petitioner is the owner of the following United States Patent and Trademark Office registrations and applications:

\* Registration No. 2,688,003, for the mark **HIGHEREDJOBS.COM**, for services identified as “personnel placement and recruitment services for academic professionals and faculty; providing access to data and the ability to manipulate data related to personnel placement and recruiting services, namely, employment candidate information, job finding tools, institutional profiles and job posting data for academic professionals and faculty; providing a website featuring information and weblinks in the field of employment for academic professionals and faculty” in International Class 35 (registration dated February 18, 2003);

\* Registration No. 2,781,127, for the mark **HIGHEREDJOBS.COM (stylized)**, for services identified as “personnel placement and recruitment services for academic professionals and faculty; providing access to data and the ability to manipulate data related to personnel placement and recruiting services, namely, employment candidate information, job finding tools, institutional profiles and job posting data for academic professionals and faculty; providing a

website featuring information and weblinks in the field of employment for academic professionals and faculty” in International Class 35 (registration dated November 11, 2003);

\* Application Serial No. 77/950,871 for the mark **HIGHEREDJOBS (stylized)**, for services identified as “personnel placement and recruitment services for academic professionals and faculty; providing access to data and the ability to manipulate data related to personnel placement and recruiting services, namely, employment candidate information, job finding tools, institutional profiles and job posting data for academic professionals and faculty; providing a website featuring information and weblinks in the field of employment for academic professionals and faculty” in International Class 35; and “on-line journals, namely, blogs featuring employment news and discussion” in International Class 41 (filed March 4, 2010);

\* Application Serial No. 77/950,843 for the mark **HIGHEREDJOBS**, for services identified as “personnel placement and recruitment services for academic professionals and faculty; providing access to data and the ability to manipulate data related to personnel placement and recruiting services, namely, employment candidate information, job finding tools, institutional profiles and job posting data for academic professionals and faculty; providing a website featuring information and weblinks in the field of employment for academic professionals and faculty” in International Class 35; and “on-line journals, namely, blogs featuring employment news and discussion” in International Class 41 (filed March 4, 2010);

3. Petitioner is currently using the Petitioner’s Marks in connection with Petitioner’s Services, offered through Petitioner’s website at [www.higheredjobs.com](http://www.higheredjobs.com), and has been using the Petitioner’s Marks in connection with at least Petitioner’s Class 35 Services since at least as early as December 10, 1996.

4. On information and belief, Petitioner first used Petitioner's Marks in connection with Petitioner's Class 35 Services in the United States prior to the date, if any, upon which Registrant first used Registrant's Mark in connection with Registrant's Services in commerce in or with the United States.

5. Petitioner first used Petitioner's Marks in connection with Petitioner's Class 35 Services in the United States prior to the date upon which Registrant filed Registrant's application to register Registrant's Mark (Application Serial No. 77/659,837) in the United States Patent and Trademark Office.

6. Petitioner first used Petitioner's Marks in connection with Petitioner's Class 35 Services in the United States prior to the date upon which Registrant's Registration No. 3,666,461 was issued by the United States Patent and Trademark Office.

7. On information and belief, Petitioner's rights in and to Petitioner's Marks are superior to Registrant's rights in Registrant's Mark by virtue of Petitioner's prior use of Petitioner's Marks.

8. Notwithstanding Petitioner's prior rights in Petitioner's Marks, on January 30, 2009, Registrant filed an intent-to-use application for the Registrant's Mark which later matured into the '461 Registration for Registrant's Services.

9. On information and belief, Registrant knew or had reason to know of Petitioner's prior rights in Petitioner's Marks when Registrant filed its application which matured into the '461 Registration.



## **COUNT I**

### **Likelihood of Confusion - §2(d)**

10. Petitioner re-alleges and incorporates herein by reference the allegations made in paragraphs 1 through 9, above, as if set forth in their entirety herein.

11. The mark which Registrant has registered in the '461 Registration so closely resembles Petitioner's Marks in appearance, sound, meaning and/or commercial impression that the use and continued registration thereof by Registrant is likely to cause confusion, mistake, and deception as to the source or origin of Registrant's services and will injure and damage Petitioner and the goodwill and reputation symbolized by the Petitioner's Marks.

12. Registrant's Services as claimed in the '461 Registration are so closely related to the Petitioner's Services and the conditions surrounding their marketing are such that they are likely to be encountered by the same purchasers under circumstances that are likely to give rise to the mistaken belief that the respective goods and services of Registrant and Petitioner come from a common source, all to Petitioner's irreparable damage and injury.

13. Continued registration of Registrant's Mark in light of the prior rights of Petitioner in its Petitioner's Marks is therefore likely to cause confusion, mistake and/or deception among members of the relevant purchasing public resulting in damage and injury to Petitioner in violation of the provisions of Section 2(d) of the Trademark Act. 15 U.S.C. §1052(d).

## COUNT II

### **Bad Faith Registration/Fraud on the Patent and Trademark Office**

14. Petitioner re-alleges and incorporates herein by reference the allegations made in paragraphs 1 through 13, above, as if set forth in their entirety herein.

15. The Registrant is a long-time competitor of the Petitioner and, upon information and belief, is well-aware of the Petitioner's existence. Furthermore, the Registrant has on occasion in the past misappropriated Petitioner's copyrighted works and ideas thus bringing the issue of bad faith into the equation of the instant petition.

16. In relation to the filing of the application for what is now the '461 Registration, Registrant executed a required Declaration which states, in pertinent part, that the authorized representative of Registrant “. . . believes Registrant to be owner of the trademark/service mark sought to be registered . . . ; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the above identified mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive . . . .”

17. As noted previously herein, Registrant is a long-time competitor of the Petitioner and knew or should have known at the time its authorized representative executed the Declaration in association with the application for the '461 Registration that Registrant did not have the right to lawfully use the mark claimed in the application and that, as a consequence, Registrant could not lawfully file the application or lawfully obtain the '461 Registration based thereon. Registrant committed fraud on the U.S. Patent and Trademark office in this regard by making a knowingly false representation in its Declaration with the intention of inducing the

U.S. Patent and Trademark Office to issue a registration to the Registrant. Registrant's knowing misrepresentation in its Declaration was material to the decision of the U.S. Patent and Trademark Office to issue the '461 Registration in reasonable reliance thereon and resulted in giving Registrant false color of right and title in and to the Registrant's Mark.

18. Under the circumstances, the filing of the application for the '461 Registration was in bad faith and unlawful, and the execution by an authorized representative of Registrant of the required Declaration therefore constituted fraud upon the U.S. Patent and Trademark Office, was material to Registrant's claim of right and title to the Registrant's Mark and the '461 Registration, was reasonably relied upon by the U.S. Patent and Trademark Office in issuing the '461 Registration, has injured and continues to injure the Petitioner, and was in violation of the provisions of Section 1(a) of the Trademark Act of 1946 (as amended)(15 U.S.C. Section 1051).

The required fee has been provided. Any additional charges should be made to the Deposit Account of Holland & Knight LLP, Account No. 50-1542.

WHEREFORE, Petitioner prays that this petition be sustained and that the '461 Registration be cancelled.

Dated: July 6, 2010

/Elizabeth R. Burkhard/

R. David Donoghue

Scott Petersen

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Attorneys for Petitioner

INTERNET EMPLOYMENT LINKAGE, INC. D/B/A

HIGHEREDJOBS

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of this foregoing Petition to Cancel Registration was served upon Registrant's correspondent of record, Dan Ouyang, AmeriCareers, LLC, 5000 Northwind Drive, Suite 218, East Lansing, Michigan 48823-5032, by First Class Mail, postage prepaid, on this 6th day of July, 2010.

/Elizabeth R. Burkhard/\_\_\_\_\_

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